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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

DONOVAN, MAUREEN C

ART UNIT

PAPER NUMBER

1761

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/689,196

Applicant(s)

SHUKLA ET AL.

Examiner

Maureen C Donovan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>1/20/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to communications: Amendment A, filed 20 January 2005.
2. Claims 1-3 are pending.
3. Claims 4-6 have been cancelled.

Specification

1. Applicant indicates in the arguments filed 20 January 2005 that US patent number 5,766,622 was incorporated by reference in the original as-filed application. The attempt to incorporate subject matter into this application by reference to US patent number 5,766,622 is however improper because mere reference to another application, patent or publication is not an incorporation of anything therein into the application containing such reference for the purpose of the disclosure required by 35 U.S.C 112, first paragraph. *In re de Seversky*, 474 F.2d 671, 177 USPQ 144 (CCPA 1973).

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3 remain rejected under 35 U.S.C. 102(b) as being anticipated by Baer, US patent number 5,011,701. The reference and rejection are incorporated as cited against claims 1-3 in the previous Office action mailed 29 October 2004.

Applicant's arguments filed 20 January 2005 have been fully considered but they are not persuasive. At pages 6 and 8 of the response, applicant states that the dietary fiber of Baer does not meet the limitations of the instant invention by not being amorphous, non-particulate, insoluble, non-coated or derived from the alkaline treatment of agricultural by-products. Additionally, on page 8 of the response that the lipid of Baer is not the same as the lipid as instantly claimed which is a fat and oil component. This is not deemed persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the dietary fiber be non-particulate, amorphous, insoluble, non-coated, or derived from agricultural by-products) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Additionally, the lipid of Baer is interpreted to be a fat and oil component, as the difference is not apparent between the referenced lipid and one that is a component, since a lipid used as a component only requires the presence of the lipid, which the referenced lipid satisfies.

Response to Amendment

3. The amendment filed 20 January 2005 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The sentences, which were added to the disclosure in the response filed 20 January 2005, that begin with:

“The dietary fiber gels are produced” , “Dietary fiber gels in a hydrated form”

and

“A physically smooth morphology”

These sentences introduce new matter regarding the production of the dietary fiber, its morphology and its physical state. Although applicant states that this matter can be added from US patent number 5,766,662; as noted above, US patent number 5,766,622 is not viewed to be incorporated by reference and therefore these amendments do introduce new matter.

Additionally, the sentence beginning “Without being bound...” that was added to the disclosure in the response filed 20 January 2005 is also new matter. This sentence introduces theories based on the information presented in US patent number 5,766,662. Since this sentence

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introduces information that is not present in US patent number 5,766,662, even if this patent is properly incorporated, this sentence would still be new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-3 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 2 of copending Application No. 10/689267. The reference and rejection are incorporated as cited against claims 1-3 in the previous Office action mailed 29 October 2004. This is a provisional obviousness-type double patenting rejection.

Applicant's arguments filed 22 December 2004 have been fully considered but they are not persuasive. At page 9 of the response, applicant states that Application No. 10/689267 is patentably distinct because it claims compositionally distinct foods. Applicant also states on page 10 that the Examiner offered no specific evidence that the inventions were not patentable distinct and states on page 11 that the ranges between the two applications are not similar.

It is submitted that Application 10/689267 does claim a food composition that would encompass the invention as instantly claimed. As stated on page 6 of the previous Office Action: "dressings and ice creams are both food products that are characterized by smooth, creamy oil

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like textures, that are viscous and fat containing, and both applications claim overlapping weight percentages that the emulsified liquid shortening is present in the foodstuffs.” The applicant has not currently argued against these statements. The ‘267 application includes a claim directed to “creamy dressing”, applicant’s submission that dressings are “oil and vinegar based thick foods” is not seen to be reflected in these claims; and additionally it is submitted that a creamy dressing by nature would indeed have a cream base. There is nothing in the definitions provided that show that dressings are required to be oil and vinegar based, or that eliminate a cream and milk base. Additionally, a separate definition by The American Heritage® Dictionary of the English Language, Fourth Edition, defines a dressing as a “sauce for certain dishes”. Nothing in the provided definition of sauce, requires it to have an oil or vinegar base, or eliminates a cream and milk base. There is also nothing precluding the use of the dairy based products as instantly claimed from being used as a sauce on a dish, for example, pie alamode. A creamy dressing therefore is interpreted to encompass the dairy products as instantly claimed. The frozen state of the dairy products does not add any patentable difference between the two applications, as dressings can be frozen, and the dairy products as instantly claimed be melted to a liquid state; additionally the state of the food product is not found to be supported by either applications’ set of claims. The ranges claimed in the ‘267 application encompasses the ranges as instantly claimed.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maureen C Donovan whose telephone number is (571) 272-2739. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MCD


KEITH HENDRICKS
PRIMARY EXAMINER